UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

SEP 26 2001

MILLEN WHITE ZELANO & BRANIGAN
ARLINGTON COURTHOUSE PLAZA I
CLARENDON BOULEVARD
SUITE 1400
ARLINGTON, VA 22201

#17

In re Application of :
Jan Endrikat et al :
Serial No.: 09/091,665 : PETITION DECISION
Filed: September 2, 1998 :
Attorney Docket No.: SCH 1637 :

This is in response to applicants' petition under 37 CFR 1.181, filed July 12, 2001, requesting withdrawal of an improper restriction requirement.

A review of the file history shows that this application is a National Stage filing of PCT/DE96/02486. The examiner mailed a first Office action to applicants on March 29, 2000, setting forth a Lack of Unity holding under 35 U.S.C. 121 and 372 dividing the claims into two groups, as follows:

> Group I, claims 1-8, drawn to a contraceptive process;
> Group II, claims 9-12, drawn to kits.

The examiner reasoned that the two Groups do not relate to a single general inventive concept as they lack the same or corresponding special technical feature. By telephone applicants elected Group I for prosecution. Claims 1-8 were also rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a). Applicants replied on June 29, 2000, by amending claims 1-7 and adding claims 13-30 and traversing the restriction requirement on the basis that the search required for the method would also be required for the kit. Reply to the art rejections was also made. On August 15, 2000, the examiner mailed a non-final Office action to applicants maintaining the restriction requirement on the basis of search burden. New rejections under 35 U.S.C. 103(a) were set forth. Applicants replied on June 16, 2001, adding claims 31-35 and again traversing the restriction requirement arguing that the claims have unity of inventions based on the estrogen/gestagen components being the special technical feature and also arguing the art rejections. The examiner mailed a Final Office action to applicants on April 5, 2001, (note - the cover sheet does not indicate the action is final, but the written text does) holding claims 9-12 and 31-35 withdrawn from consideration as being to a non-elected invention for the reason previously set forth and maintaining the rejections under 35 U.S.C. 103(a). Applicants filed a Notice of Appeal on July 5, 2001. This petition was filed July 11, 2001. An Appeal Brief was filed September 5, 2001.

DISCUSSION

37 CFR 1.144 which states as follows:

> 37 CFR 1.144. Petition from requirement for restriction.
>
> After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.)

This petition was filed seven days after the Notice of Appeal was filed and is therefor untimely. As further commentary, applicants suggest that the estrogen/gestagen compound/composition as the special technical feature. However, a special technical feature is one that contributes to (defines over) the prior art. Inasmuch as the alleged special technical feature has not been found to avoid the prior art, it cannot provide support for Unity of Invention under PCT Rule 13.1 - 13.2 guidelines.

The petition is **DISMISSED** as untimely and for other reasons set forth above.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll John Doll
Director, Technology Center 1600